

**REMARKS**

Claims 1 and 10 have been amended to resolve issues raised by the Examiner under 35 U.S.C. 112, second paragraph. Claims 5 and 6 have been amended so that they are in independent form. Non-elected claims 13-20 have been canceled.

Entry of the above amendments is respectfully requested.

**Restriction Requirement**

On page 2 of the Office Action, in paragraph 1, the Examiner sets forth the restriction requirement issued originally by telephone, in which restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to a magnetic particle coated material, and
- II. Claims 13-20, drawn to a method of making a magnetic particle coated material.

The Examiner notes that a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12, and that affirmation of this election must be made when replying to the Office action.

In response to this restriction requirement, Applicants hereby affirm the election of Group I, claims 1-12, without traverse.

**Rejection under 35 U.S.C. 112, Second Paragraph**

On page 3 of the Office Action, in paragraph 7, claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

### **The Examiner's Position**

Based on the reasons given by the Examiner, the Examiner's position is as follows:

(1) Claims 1 and 10 lack clear antecedent basis for "the magnetic layer" in lines 8 and 2, respectively. In particular, according to claim 1, there are two magnetic layers is the "magnetic particle coated material." It is not clear which one of these layers "the magnetic layer" refers to (or if it refers to both).

(2) Claim 1 is rendered indefinite by the use of the phrase "CuAu type" and "Cu<sub>3</sub>Au type", because it has been held that the use of the term "type" renders the scope of an otherwise definite expression indefinite.

### **Applicants' Response**

Applicants' comments on each of the issues raised by the Examiner are as follows:

(1) Based on the disclosure, e.g., at page 6, lines 6-8, and in the Examples, Applicants submit that "the magnetic layer" in line 8 of claim 1 and line 2 of claim 10 refers to both the magnetic layer on the first support and the magnetic layer on the second support. Accordingly, Applicants have amended line 8 of claim 1 and line 2 of claim 10 to change "the magnetic layer" to "each magnetic layer" to resolve the first issue raised by the Examiner.

(2) With respect to "CuAu type" or "Cu<sub>3</sub>Au type", Applicants have amended the expressions at issue to insert a hyphen before the word "type", and Applicants submit that the amended terms are well known in the art and can be found, for example, in J. Appl. Phys., 93(1), 453-457 (2003) and Jpn. J. Appl. Phys., 39, part 2, No. 11B 1121-1123 (2000), copies of which

are attached hereto. Applicants submit that such resolves the second issue raised by the Examiner.

Thus, Applicants submit that the amended claims satisfy the requirements of 35 U.S.C. 112, 2nd paragraph. Accordingly, withdrawal of this rejection is respectfully requested.

### **Obviousness Rejection**

On page 4 of the Office Action, in paragraph 9, claims 1-4 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh et al (US 6127039) in view of Murray et al (US 6254662).

#### **The Examiner's Position**

The Examiner's position is basically that Saitoh et al teach a magnetic recording medium having a non-magnetic base layer coated on each side with a layer of non-magnetic coating mix wherein each non-magnetic coating layer is further coated with a magnetic layer containing a FePt alloy magnetic powder. While the Saitoh reference fails to teach that the FePt powder has the claimed CuAu/Cu<sub>3</sub>Au ordering, the Examiner indicates that Murray et al teach that it is known to use FePt binary alloy particles in order to provide particulate magnetic media exhibiting narrower transitions and reduced read back noise, and detail the use of FePt particles having a CuAu crystal structure deposited on a substrate to form thin film media. The Examiner asserts that it would have been obvious to substitute the FePt, CuAu-type particles taught by Murray et al for the FePt based magnetic particles taught by Saitoh et al in order to provide a medium exhibiting narrower transitions and higher read output.

### **Applicants' Response**

In response to this rejection, Applicants submit that it appears that Saitoh discloses a single base (support) which may be coated on each side with a non-magnetic layer on which a magnetic layer is coated (see, e.g., the Abstract).

However, such a single support design is manufactured by a method such as one discussed in the disclosure from page 2, line 23 to page 3, line 20 in the present specification.

Further, as discussed in that disclosure, such a method can cause the magnetic property to vary widely between the magnetic layers or or can cause scratches on one of the surfaces.

Accordingly, the present invention requires two supports (i.e., the first support and the second support as recited in claim 1), which enables the aforementioned problems to be solved (since magnetic layers with substantially the same magnetic property and without scratches can be formed as described in the disclosure beginning at page 5 in the present specification).

Since Saitoh neither teaches nor suggests that its support is formed from two separate supports, Applicants submit that Saitoh's structure neither teaches nor suggests the structure of the present invention, such that the present invention is not obvious from Saitoh. Further, since Murray does not make up for the deficiency of Saitoh, Applicants submit that the combination of Saitoh in view of Murray neither teaches nor suggests the present invention, such that the present invention is not obvious over the cited art combination.

Also, Applicants submit that while the Saito reference does disclose that an element such as platinum or palladium may be included in an Fe magnetic body, these elements are described in parallel with many elements that do not form a CuAu-type alloy with iron, such as silicon and

chromium. Applicants submit that it would not have been obvious for one of ordinary skill in the art to select platinum or palladium, which form a CuAu-type alloy with iron, and to combine these elements with the disclosure of the Murray reference.

In any event, Applicants submit that the feature of the first and second supports being attached to each other, which is recited in claim 1 and is not disclosed in either of the two cited references, provides an excellent effect of decreasing the difference in magnetic characteristics between the two supports even when these supports are annealed to obtain magnetic particles having a CuAu or Cu<sub>3</sub>Au-type ferromagnetic ordered alloy phase. Applicants submit that this remarkable effect would not have been obvious from the cited references.

In view of the above, Applicants submit that the present invention is not obvious over Saitoh in view of Murray. Accordingly, withdrawal of this rejection is respectfully requested.

#### **Allowable Subject Matter**

On page 5 of the Office Action, in paragraph 10, the Examiner indicates that claims 5-6 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, and to include all of the limitations of the base claim and any intervening claims, because the closest prior art as applied above fails to teach or suggest the claimed ratios.

Applicants thank the Examiner for indicating that claims 5-6 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, and to include all of the limitations of the base claim and any intervening claims. In view of the above amendment of claims 5 and 6 rewriting those claims to overcome the rejection under 35 U.S.C. 112, 2nd

paragraph, and to include all of the limitations of the base claim (there are no intervening claims), Applicants submit that claims 5 and 6 are allowable. Further, in view of the above amendments and remarks, Applicants submit that the other pending claims are allowable as well, and thus allowance of all the pending claims is respectfully requested.

### Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

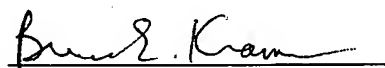
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